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Attorneys for Plaintiff and Counter-Defendant CENTOCOR ORTHO BIOTECH, INC. and Third-Party Defendants GLOBAL PHARMACEUTICAL SUPPLY GROUP, LLC, CENTOCOR BIOLOGICS, LLC and JOM PHARMACEUTICAL SERVICES, INC.

CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION

CENTOCOR ORTHO BIOTECH,
INC.,

Plaintiff,

V.

GENENTECH, INC. and CITY OF
HOPE,

Defendants.

Case No. CV 08-03573 MRP (CTx)

**PLAINTIFF'S *EX PARTE*
APPLICATION FOR LEAVE TO
TAKE DEPOSITION OF WITNESS
JEFFREY KUSHAN AFTER THE
DISCOVERY CUT-OFF DATE**

Date: TBA
Time: TBA
Place: Hon. Mariana Pfaezler,
Courtroom 12

AND RELATED COUNTER AND
THIRD-PARTY ACTIONS.

1 **I. INTRODUCTION**

2 Pursuant to Local Rule 7-19, Plaintiff Centocor Ortho Biotech, Inc.
3 (“Centocor”) hereby applies *ex parte* to the Court for leave, if necessary, to take the
4 deposition of third-party witness Jeffrey Kushan after the Discovery Cut-Off date of
5 April 30, 2010.

6 Mr. Kushan is a third-party witness and serves as Defendant Genentech, Inc.’s
7 (“Genentech”) outside patent counsel. Centocor served Mr. Kushan on April 21,
8 2010, pursuant to Rule 45 by means of a deposition subpoena issued from the District
9 Court for the District of Columbia. Counsel for Genentech also represents Mr.
10 Kushan and has indicated that it would not make Mr. Kushan available for his
11 deposition. Centocor has filed an emergency application with the D.C. District Court
12 seeking to compel Mr. Kushan’s compliance with the subpoena. In the event that the
13 D.C. District Court grants Centocor’s application and Mr. Kushan’s deposition is
14 unable to proceed prior to April 30, 2010, the discovery cut-off date, Centocor seeks
15 leave from this Court to take Mr. Kushan’s deposition on a date after April 30.

16 This *ex parte* application is being filed because fact discovery in this case
17 closes on April 30, 2010 and Centocor is unable to bring a noticed motion prior to the
18 Discovery cut-off. On April 27, 2010, Keith D. Fraser, counsel for Centocor,
19 contacted Matthew Shiels, counsel for defendant Genentech and advised him of the
20 substance of this *ex parte* application and of plaintiff’s intent to file it today. At the
21 time of this filing, counsel has not indicated whether Defendants would oppose
22 Plaintiff’s *ex parte* application. However, Mr. Shiels has informed Centocor that
23 Genentech intends to move *ex parte* for a protective order that the deposition of Mr.
24 Kushan not take place. The contact information for Defendants’ counsel Genentech,
25 Inc. is as follows:

1 Mark A. Pals
2 Marcus E. Sernel
3 Matthew J. Shiels
4 Kirkland & Ellis LLP
5 300 North LaSalle Street
6 Chicago, IL 60654
7 Tel: 312-861-2000
8 Email: mpals@kirkland.com
9 msernel@kirkland.com

10 Daralyn J. Durie
11 Ryan Kent
12 Durie Tangri, LLP
13 217 Leidesdorff Street
14 San Francisco, CA 94111
15 Tel: 415-362-6666
16 Email: ddurie@durietangri.com
17 rkent@durietangri.com

18 **II. SUMMARY OF FACTS**

19 Centocor initiated this litigation by filing a declaratory judgment action
20 seeking a ruling that Genentech's "Cabilly II" Patent is invalid or not enforceable.
21 The Cabilly II Patent was involved in a lengthy reexamination proceeding at the U.S.
22 Patent and Trademark Office. Mr. Kushan, who is a partner with the firm of Sidley
23 Austin LLP, was the attorney who handled that reexamination proceeding for
24 Genentech. Centocor has asserted and pleaded that the Cabilly II Patent is
25 unenforceable due to inequitable conduct. On April 21, 2010, it served Supplemental
26 Interrogatory Responses on Genentech in support of its inequitable conduct defense.
27 (Ex. E).

28 On April 19, 2010, more than ten days before the close of fact discovery,
counsel for Centocor corresponded via electronic mail with counsel for Genentech
regarding whether Genentech would accept service of a deposition notice for Mr.
Kushan. Attached to that correspondence was a Notice of Deposition for Jeffrey
Kushan. Genentech's counsel agreed to accept service of process. On April 21,
Centocor served a subpoena for the deposition of Mr. Kushan on counsel for

1 Genentech, setting an April 30 deposition, at 9:00 a.m., in the D.C. offices of Akin
2 Gump Strauss Hauer & Feld LLP (Ex. A).

3 By letter dated April 23, 2010, counsel for Genentech informed Centocor that
4 it would not be producing Mr. Kushan for deposition (Ex. B). Later that same day,
5 Centocor again explained that Mr. Kushan has been identified as a witness with
6 knowledge relevant to the litigation, and asked that Genentech reconsider producing
7 Mr. Kushan for deposition (Ex. C). Counsel for the parties met and conferred via
8 telephone on April 26, 2010 and were unable to resolve this issue.

9 Because discovery is set to close on April 30, 2010 in this litigation, and
10 because this issue has already been under Genentech's consideration for a week,
11 Centocor asked Genentech to advise it by 3:00 EDT on April 26 whether it would
12 produce Mr. Kushan so that, if Genentech refused, Centocor could seek the Court's
13 intervention. Genentech did not reply by the appointed time. Thereafter, Centocor
14 filed an Emergency Application in the D.C. District Court seeking to compel
15 Mr. Kushan's compliance with the subpoena and ordering Mr. Kushan to appear on
16 April 30 for his scheduled deposition. (Ex. D).

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18 **III. ARGUMENT**

19 Pursuant to Rule 16(b)(4), a Court may modify a Scheduling Order upon a
20 showing of good cause. Good cause exists for amending the Scheduling Order to
21 allow for the deposition of Mr. Kushan. Mr. Kushan was properly served with the
22 deposition notice and subpoena on April 21, well before the discovery cut-off and
23 with sufficient time for Mr. Kushan to prepare and appear for his deposition on
24 April 30. Mr. Kushan's counsel, also counsel for Genentech, knew of Centocor's
25 intention to take Mr. Kushan's deposition a full eleven days before the discovery cut-
26 off. As set forth in Centocor's ex parte application to compel compliance with the
27 subpoena, Genentech has no basis for objecting to the deposition and for refusing to
28 produce Mr. Kushan. Despite being served with the valid subpoena, neither

1 Genentech nor Mr. Kushan moved to quash the subpoena in the D.C. Court. Instead,
2 Genentech engaged in a time consuming meet and confer process with Centocor until
3 finally ending such communications days before the end of discovery.

4 Attorneys who prosecute patent applications are regularly deposed in
5 subsequent patent litigation. *V. Mane Fils, S.A. v. International Flavors and*
6 *Fragrances, Inc.*, 2008 WL 3887621, at *3-4 (D.N.J. Aug. 20, 2008). In fact,
7 Genentech has not objected to producing two other attorneys who had responsibility
8 for certain aspects of the prosecution of the Cabilly II Patent before the U.S. Patent
9 and Trademark Office. If Genentech has an issue with the sufficiency of Centocor's
10 pleading of inequitable conduct (and it should not), that is an issue to take up at a
11 later date. It is not a reason for refusing to produce for deposition a witness who is
12 relevant and who was timely served with a subpoena.

13 Good cause exists for modifying a Scheduling Order if "it cannot reasonably
14 be met despite the diligence of the party seeking the extension." *Johnson v.*
15 *Mammoth Recreations, Inc.*, 975 F. 2d 604, 609 (9th Cir. 1992) (*citing* Fed. R. Civ.
16 P. 16 advisory committee notes (1983 amendment)). Here, Centocor has been
17 diligent. It noticed Mr. Kushan's deposition within a reasonable time within the
18 discovery period. It is Genentech's interference in Centocor's valid attempts to
19 conduct the discovery that has resulted in Centocor's request to take the deposition
20 after the discovery cut-off.

21 Accordingly, to the extent that the D.C. District Court orders that Mr. Kushan
22 comply with the deposition subpoena on a date after April 30, Centocor requests that
23 this Court amend the Scheduling Order for the limited purpose of taking Mr. Kushan
24 deposition after April 30.

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1 **IV. CONCLUSION**

2 For the foregoing reasons, it is requested that, in the event that the D.C.
3 District Court orders that the deposition of Mr. Kushan go forward, this Court grant
4 Centocor leave to take his deposition after the Discovery Cut-off date of April 30,
5 2010, if necessary.

6
7 DATED: April 27, 2010

Respectfully submitted,

8 AKIN GUMP STRAUSS HAUER & FELD LLP

9 By: /s/ Dianne B. Elderkin
10 Dianne B. Elderkin

11 and

12 CONNOLLY BOVE LODGE & HUTZ LLP

13 By: /s/ Bruce G. Chapman
14 Bruce G. Chapman

15 Attorneys for Plaintiff and Counter-Defendant
16 Centocor Ortho Biotech, Inc. and Third-Party
17 Defendants Global Pharmaceutical Supply
18 Group, LLC, Centocor Biologics, LLC and
19 JOM Pharmaceutical Services, Inc.
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CERTIFICATE OF SERVICE

I, Dori Dellisanti, the undersigned, certify and declare that I am over the age of 18 years, employed in the County of Los Angeles, State of California, and not a party to the above-entitled cause. My business address is Connolly Bove Lodge & Hutz LLP, 333 South Grand Avenue, Suite 2300, Los Angeles, California 90071.

On April 27, 2010, I served the foregoing documents described as:

(1) PLAINTIFF'S *EX PARTE* APPLICATION FOR LEAVE TO TAKE DEPOSITION OF WITNESS JEFFREY KUSHAN AFTER DISCOVERY CUT-OFF DATE; and

on the following person(s) in this action by placing a true copy thereof enclosed in sealed envelope addressed as follows:

David I Gindler Joseph M Lipner Irell and Manella 1800 Avenue of the Stars Suite 900 Los Angeles, CA 90067-4276	Attorneys for Defendant and Counterclaimant City of Hope Medical Center Tel: 310-277-1010 Fax: 310-203-7199 Email: jlipner@irell.com ; dgindler@irell.com Coh.centocor.team@irell.com
Mark A. Pals Marcus E Sernel Matthew Shiels Kirkland and Ellis LLP 300 North LaSalle Street Chicago, IL 60654	Attorneys for Defendant and Counterclaimant Genentech, Inc. Tel: 312-861-2000 Fax: 312-861-2200 Email: mpals@kirkland.com msernel@kirkland.com
Daralyn J. Durie Ryan Kent Durie Tangri Lemley Roberts & Kent LLP 332 Pine Street Suite 200 San Francisco, CA 94104	Attorneys for Defendant and Counterclaimant Genentech, Inc. Tel: 415-362-6666 Email: ddurie@durietangri.com rkent@durietangri.com

[] BY MAIL I am readily familiar with the firm's practice regarding collection and processing of correspondence for mailing. Under that practice it would be deposited with U.S. Postal Service on that same day with postage thereon fully prepaid at Los Angeles, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

[] BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the addressee(s) as stated above.

[] FEDERAL EXPRESS: I am readily familiar with the office practice of Connolly Bove Lodge & Hutz LLP for collecting and processing correspondence for overnight delivery by Federal Express. Such practice is that when correspondence for overnight delivery by Federal Express is deposited with the

1 Connolly Bove Lodge & Hutz LLP personnel responsible fore delivering
 2 correspondence to Federal Express, such correspondence is delivered to a Federal
 3 Express location or to an authorized courier or driver authorized by Federal
 4 Express to receive documents or deposited at a facility regularly maintained by
 5 Federal Express for receipt of documents on the same day in the ordinary course
 6 of business.

7 [X] **BY E-MAIL:** (1) I caused copies of the above documents to be emailed to the
 8 interested parties based on the email addresses indicated herein, and/or (2) based
 9 on General Order 08-02, the attached document(s) was sent to the person(s) at
 10 the e-mail addres(es) indicated above through the Court's Electronic Filing
 11 System (ECF).

12 [X] **FEDERAL** I declare that I am employed in the office of a member of the bar of
 13 this court at whose direction the service was made.

14 I hereby declare under penalty of perjury that the foregoing is true and correct.
 15 Executed on April 27, 2010 at Los Angeles, California.

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 Name

 Signature